

**REMARKS**

Claims 1-10 are pending in the application. Claims 1, 6 and 10 are amended. It is respectfully submitted that this Amendment is fully responsive to the Office Action dated November 17, 2005.

Claims 1, 3-4 and 8-10 were rejected under 35 U.S.C. §112, second paragraph as being indefinite.

In rejecting these claims, the Examiner asserted that the element -- “the height is larger than 0.9 times the width” -- is incorrect and concludes that for the purpose of examination “the height is larger than 1.1 times the width” or “the width is smaller than 0.9 times the height” is assumed. In particular, the Examiner asserted that according to the specification (page 14, lines 13-14 and Fig. 4), the height is required to be larger than the width and when comparing the sizes of the bead, the height is *not* 0.9 times the width (i.e., the height is less than the width.)

Applicants respectfully disagree with the Examiner’s conclusion. For example, if the height of the bead is 1.4 mm and the width of the bead is 1.3 mm, then the height of the bead is larger than 0.9 times the width (i.e., 0.9 times the width is 1.17 mm and the height is 1.4 mm.) Accordingly, claims 1, 3-4, and 8-10 are not indefinite and the rejection should be withdrawn.

Claims 1-2, 5, 8 and 10 were rejected under 35 U.S.C. §102(b) as being anticipated by *Kitamura et al.* (U.S. Pat. No. 6,139,639). To expedite prosecution and clarify the subject matter of this invention, Applicants hereby amend claim 1 to emphasize that the nozzle is parallel to the surface and that the distance between the discharge port and the surface is 1.5 – 3X the height of

Amendment under 37 C.F.R. §1.116  
Application No. 10/500,303  
Attorney Docket No. 042471

the bead. In view of this amendment and the following remarks, Applicants respectfully submit that claims 1-2, 5, 8, and 10 are distinguished from the cited reference.

Briefly, anticipation requires the presence in a single prior art reference the disclosure of each and every element of the claimed invention, arranged as in the claim. The PTO has the burden of making out a prima facie case, which requires it to produce the factual basis for its rejection in an application under §102. Here, for example, *Kitamura et al.* fails to disclose a material application apparatus wherein a *discharge port is formed into a non-circular configuration and discharges said material to form a bead having a sectional configuration in which the height is larger than 0.9 times the width.* [Claim 1]. The Examiner merely states that *Kitamura et al.*'s applicator or die is capable of forming beads having a sectional configuration in which the height larger than 1.1 times the width by exchanging different shims [Office Action, page 3.]

Also, *Kitamura et al.* does not disclose a material application apparatus wherein a *discharge port is formed into a non-circular configuration.* [Claim 1]. For example, the front lip 58 and rear lip 60 of the die 40 is not a discharge port.

In view of the amendments to claim 1 and the above remarks, Applicants respectfully submit that the Examiner has failed to make a prima facie case of anticipation. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 1-2, 5, 8, and 10.

Claims 1 and 8-9 were also rejected under 35 U.S.C. §102(b) as being anticipated by *Dominguez* (U.S. Pat. No. 4,964,362). However, in view of the amendments to claim 1 and the

Amendment under 37 C.F.R. §1.116  
Application No. 10/500,303  
Attorney Docket No. 042471

remarks above, Applicants respectfully submit that these claims distinguish over the cited reference. Accordingly, Applicants respectfully request that the Examiner withdraw this anticipation rejection of claims 1 and 8-9.

Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Dominguez* (U.S. Pat. No. 4,964,362) in view of *Clitheros et al.* (U.S. Pat. No. 4,564,410). However, claims 3 and 4 depend from independent claims 1 and 2. Thus, these claims are likewise allowable by nature of dependency. Accordingly, Applicants respectfully request that the Examiner allow claims 3 and 4.

Applicants appreciate the Examiner's acknowledgement that claims 6 and 7 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. To expedite prosecution, Applicants hereby amend claims 6 to incorporate the limitations of the base claim and any intervening claims. In view of this, Applicants respectfully request that the Examiner allow claims 6 and 7, which depends from claim 6.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

Amendment under 37 C.F.R. §1.116  
Application No. 10/500,303  
Attorney Docket No. 042471

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,  
**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read "Darrin A. Auito".

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